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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,929	02/12/2002	Pei-Chung Liu	MR1115-378	3749

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ROSENBERG, KLEIN & LEE  
3458 ELLICOTT CENTER DRIVE-SUITE 101  
ELLICOTT CITY, MD 21043

EXAMINER
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BAUM, RONALD

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/072,929

Applicant(s)

LIU, PEI-CHUNG

Examiner

Ronald Baum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

1. Claims 1- 8 are pending for examination.
2. Claims 1- 8 are rejected.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1- 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarat, U.S. Patent 6,581,122 B1.
4. As per claim 1; “A USB-based data security device comprising:  
a USB mass storage class controller connected to a USB-interfaced operation system for carrying out USB protocol commands issued by the operation system [Abstract, col. 1,line 20-col. 8,line 12, whereas the processor based smartcard with USB interfacing (i.e., figure 3 and associated description) is used ‘... to control the communications from the CPU 10 to any other peripheral devices (i.e., the computer RAM, hard drive, or any other mass storage associated with said computer) ...’, ‘... a personal computer with a USB port is inherently smartcard enabled...’, and ‘... (i.e., col. 7,lines 7-60) bulk encryption and decryption, where the card can operate as a pass-through device.’, clearly encompasses the claimed limitations as broadly interpreted by the examiner.]; and

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a data protection device connecting the USB mass storage class controller to a data storage device,

the data protection device comprising

a write protection unit,

an enciphering unit and

a deciphering unit,

the write protection unit and

the enciphering unit respectively providing

write protection of the data storage medium and

enciphering data when data are to be written by the

operation system into the data storage medium,

the deciphering unit

deciphering data from the data storage medium when the

operation system reads the data from the data storage medium

[Abstract, col. 1, line 20-col. 8, line 12, whereas the processor based

smartcard with USB interfacing (i.e., figure 3 and associated

description) is used ‘... to control the communications from the

CPU 10 to any other peripheral devices (i.e., the computer RAM,

hard drive, or any other mass storage associated with said

computer) ...’, ‘... a personal computer with a USB port is

inherently smartcard enabled...’, and ‘... (i.e., col. 7, lines 7-60)

bulk encryption and decryption, where the card can operate as a

pass-through device.’, clearly encompasses the claimed limitations as broadly interpreted by the examiner.]”.

5. Claim 2 *additionally recites* the limitation that; “The USB-based data security device as claimed in claim 1, wherein

the USB mass storage class controller and  
the data protection device are incorporated in  
a USB-based data accessing device.”.

The teachings of Sarat suggest such limitations (Abstract, col. 1, line 20-col. 8, line 12, whereas the processor based smartcard with USB interfacing (i.e., figure 3 and associated description) is used ‘... to control the communications from the CPU 10 to any other peripheral devices (i.e., the computer RAM, hard drive, or any other mass storage associated with said computer) ...’, ‘... a personal computer with a USB port is inherently smartcard enabled...’, and ‘... (i.e., col. 7, lines 7-60) bulk encryption and decryption, where the card can operate as a pass-through device.’, and further, where the smartcard clearly can interface with the computer and its associated interface devices (... USB-based data accessing device ...), clearly encompasses the claimed limitations as broadly interpreted by the examiner.).

6. Claim 3 *additionally recites* the limitation that; “The USB-based data security device as claimed in claim 2, wherein

the USB-based data accessing device comprises  
a USB-based card reader.”.

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The teachings of Sarat suggest such limitations (Abstract, col. 1, line 20-col. 8, line 12, whereas the processor based smartcard with USB interfacing (i.e., figure 3 and associated description) is used ‘... to control the communications from the CPU 10 to any other peripheral devices (i.e., the computer peripheral devices inclusive of plural smartcard(s) readers associated with said computer) ...’, ‘... a personal computer with a USB port is inherently smartcard enabled...’, and ‘... (i.e., col. 7, lines 7-60) bulk encryption and decryption, where the card can operate as a pass-through device.’, and further, where the smartcard clearly can interface with the computer and its associated interface devices (... USB-based card reader ...), clearly encompasses the claimed limitations as broadly interpreted by the examiner.).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarat, U.S.

Patent 6,581,122 B1 as applied to claim 1 above.

7. Claim 4 ***additionally recites*** the limitation that; “The USB-based data security device as claimed in claim 1, wherein

the data storage medium comprises a compact flash card.”.

8. Claim 5 *additionally recites* the limitation that; “The USB-based data security device as claimed in claim 1, wherein

the data storage medium comprises a multi-media card.”.

9. Claim 6 *additionally recites* the limitation that; “The USB-based data security device as claimed in claim 1, wherein

the data storage medium comprises a memory stick.”.

10. Claim 7 *additionally recites* the limitation that; “The USB-based data security device as claimed in claim 1, wherein

the data storage medium comprises a smart media card.”.

11. Claim 8 *additionally recites* the limitation that; “The USB-based data security device as claimed in claim 1, wherein

the data storage medium comprises a security digital card.”.

The teachings of Sarat suggest the base claims limitations (see “As per claim 1...” paragraph above) *without explicitly teaching* of the use of “... the data storage medium comprises ... compact flash card ... multi-media card ... memory stick ... smart media card ... security digital card”, as a form of mass storage functionality per se.

It would have been obvious to one ordinary skill in the art at the time the invention was made to store any type of information including sensitive, encrypted, or otherwise, data in any generally electrically compatible mass storage device/system component. A recitation directed to the manner in which a claimed apparatus is *intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform* (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)). The *prior art is replete with references disclosing generally electrically compatible mass storage device/system components used to store any type of information including sensitive, encrypted, or otherwise, data.*




*Conclusion*

12. Any inquiry concerning this communication or earlier communications from examiner should be directed to Ronald Baum, whose telephone number is (571) 272-3861, and whose unofficial Fax number is (571) 273-3861. The examiner can normally be reached Monday through Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached at (571) 272-3795. The Fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. For more information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald Baum  
Patent Examiner



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